

REMARKS

The Final Office Action dated October 17, 2007 contained a final rejection of claims 1-6, 8-17 and 19-33. The Applicant has amended claims 1, 15, 18 and 25. Claims 1-6, 8-17 and 19-33 are in the case. Please consider the present amendment with the attached Request for Continued Examination (RCE) under 37 C.F.R. § 1.114. This amendment is in accordance with 37 C.F.R. § 1.114. Reexamination and reconsideration of the application, as amended, are requested.

The Office Action rejected claims 1-8, 14-18 and 25-30 under 35 U.S.C. § 103(a) as being unpatentable over Ostover (U.S. Patent No. 6,585,154). The Office Action rejected claims 9-13 and 19-24 under 35 U.S.C. § 103(a) as being unpatentable over Ostover (U.S. Patent No. 6,585,154) in view of Official Notice. The Office Action rejected claim 31 under 35 U.S.C. § 103(a) as being unpatentable over Ostover (U.S. Patent No. 6,585,154) in view of the Applicant's Background.

The Applicant respectfully traverses these rejections based on the amendments to the claims and the arguments below.

The Applicant's claimed invention now includes placing an encoded digital image copy of a barcode representation of the first photo-based image on the media, wherein a reprint of the picture is obtainable by a reading of the encoded digital image copy of a barcode representation from the media.

In contrast, the combined references are missing the above **newly** added features as specifically claimed. Specifically, the combined references (the Background of the Invention was combined with Ostover by the Examiner in two of the three rejections) merely disclose a document with a chip affixed to the surface of the document. Clearly, the combination is still missing the newly added placing an encoded digital image copy of a barcode representation of the first photo-based image on the media and **encoding redundant information**, wherein if portions of the photo-based image are lost or damaged, the redundant information is configured to compensate for the loss or damage to prevent the loss or damage from interfering with reproduction of the photo-based image of the Applicant's claimed invention.

Further, even though the combined references do not disclose, teach, or suggest all of the features of the Applicant's claimed invention, the references should **not** be considered together because Ostover et al. teach away from the Applicant's claimed invention. MPEP section 2143.01, part V. clearly states that "[I]f proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Also, MPEP section 2143.01, part VI. states that "[I]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

Namely, Ostover et al. **explicitly** disclose that the system includes "...a ***microchip memory device affixable*** to a document..." [***emphasis added***] (see Abstract of Ostover et al.). The microchip in Ostover et al. is **required** for proper operation. In contrast, the Applicant's claimed invention does **not** require a microchip nor does it require the microchip to be affixed to the document. Instead, the Applicant's claimed invention uses an encoded **digital image** copy of a **barcode representation**. In other words, the Applicant's claimed invention uses a non-physical microchip device in the form of digital image and **does not require** something to be affixed to the document, which is required in Ostover et al.

Consequently, the proposed modification or combination would render Ostover et al. being modified unsatisfactory for its intended purpose and would change the principle of operation of the invention in Ostover et al. being modified. This is because Ostover et al. explicitly **require** a microchip to be affixed to the document, **unlike** the Applicant's newly claimed invention which uses an encoded **digital image** copy of a **barcode representation** and **does not require** something to be affixed to the document.

Therefore, this "teaching away" prevents this reference from being used by the Examiner. ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). Thus, since the Applicant's claimed elements are **not** disclosed, taught or suggested by the combined references and because Ostover et al.

teach away from the Applicant's invention, Ostover et al. **cannot** be used as a reference alone or in combination with other references, and hence, the Applicant submits that the rejection should be withdrawn. *MPEP 2143*.

Also, the Examiner is reminded that these references **should not** be considered together with the benefit of hindsight. It is well-settled in the law that improper hindsight occurs when knowledge and advantages from the Applicant's disclosure is used or words or phrases are arbitrarily picked and chosen from references to recreate the Applicant's invention. *Crown Operations International, Ltd. v. Solutia, Inc.*, 289 F.3d 1367, 62 USPQ2d 1917 (Fed. Cir. 2002). In particular, the combination of elements in a manner that reconstructs the Applicant's invention only with the benefit of **hindsight** is insufficient to present a prima facie case of obviousness. *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.*, 796 F.2d 443, 230 USPQ 416 (Fed. Cir. 1986).

Even if the references in question seem relatively similar "...**the opportunity to judge by hindsight is particularly tempting**. Hence, the tests of whether to combine references need to be applied rigorously," especially when the Examiner uses a reference that does not explicitly disclose the exact elements of the invention or **teaches away** from the Applicant's claimed invention, which is the case here. *McGinley v. Franklin Sports Inc.*, 60 USPQ 2d 1001, 1008 (Fed. Cir. 2001). Since hindsight cannot be used to support the rejections, the combined cited references cannot render the Applicant's invention obvious and the rejection is improper and should be withdrawn. *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.* Accordingly, this teaching away and the failure of the cited references to disclose, suggest or provide motivation for the Applicant's claimed invention indicates a lack of a prima facie case of obviousness (*MPEP 2143*).

Further, with regard to the dependent claims, since they depend from the above-argued respective independent claims, they are therefore patentable on the same basis. (*MPEP* § 2143.03). Also, the other references cited by the Examiner also have been considered by the Applicant in requesting allowance of the dependant claims and none have been found to teach or suggest the Applicant's claimed invention.

Thus, it is respectfully requested that all of the claims be allowed based on the amendments and arguments. Accordingly, the Examiner is respectfully requested to

withdraw the outstanding rejection of the claims and to pass this application to issue. Additionally, in an effort to further the prosecution of the subject application, the Applicant kindly **requests** the Examiner to telephone the Applicant's attorney at **(818) 885-1575**.

Please note that all mail correspondence should continue to be directed to
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